

REMARKS/ARGUMENTS

Responsive to the Office Action mailed August 12, 2008:

I. NON-PRIOR ART MATTERS

- A. The Office Action rejected claims 2, 3 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

Appropriate amendments are enclosed herein.

II. PRIOR ART MATTERS

- A. The Office Action rejected claims 1-5, 7-16 under 35 USC 102() as being anticipated by Qi. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹ "For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review."² "This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event."³

As to claim 1, Qi does not disclose:

- a messaging system associated with the collaboration session manager.
- reception by the messaging system associated with the collaboration session manager, of a message generated by a collaboration session client, the message comprising a plurality of addresses of clients of the collaboration session.

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984); *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1370, 62 U.S.P.Q.2D (BNA) 1865 (Fed. Cir. 2002).

² *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

³ *Moy's Walker on Patents*, 4th ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D(BNA) 1655 (Fed. Cir. 1990))

In order to anticipate under 35 U.S.C. § 102, "the prior art reference...must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim'."⁴

In Qi, there is no disclosure of a messaging system associated with the collaboration session manager or the receipt of a message from the collaboration session client by the messaging system. In Qi, the collaboration session manager (CSM) receives directly a collaboration session request initiated by the user of a client computer. [0025] Further, this collaboration session request is not a message directed to the messaging system, but a specific request to implement a service, flowing outside the messaging system. [0025]

Therefore claim 1 is allowable over Qi.

Claims 2-5 contain additional elements and/or limitations beyond allowable claim 1 and are therefore also allowable.

As to claim 7, Qi does not disclose:

- a messaging system (101) associated with a client of the collaboration system.
- reception, by the messaging system associated with a client of the collaboration system, of a message generated by a messaging system associated with a collaboration session manager, the message comprising the identifier of an activated collaboration service;
- establishment, by the collaboration software (103) associated with the client, of a collaboration session from the identifier of the collaboration session activated.

In Qi, there is no disclosure of a messaging system associated with a client of the collaboration system or of a messaging system associated with the collaboration session manager. There is therefore no receipt, by a messaging system associated with a client of the

⁴*Net Moneyin, Inc. v. Versign, Inc.* (Fed. Cir. Appeal No. 2007-1565, decided October 20, 2008) (holding that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.")

collaboration system, of a message generated by a messaging system associated with the collaboration manager. Therefore claim 7 is allowable over Qi.

Claims 8-11 contain additional elements and/or limitations beyond allowable claim 7 and are also allowable.

Claims 12, 13, and 14 are allowable for reasons similar to those discussed above in regard to claims 1 and 7.

Claims 15 and 16 are allowable because the claim a computer program containing instructions for implementing the methods of claims 1 and 7, respectively.

B. The Office Action rejected claim 6 under 35 USC 103(a) as being unpatentable over Qi in view of Costa-Requena.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁵ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.⁶

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁷

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach or suggest all the claim limitations.

⁵MPEP Sec. 2142.

⁶Id.

⁷Id. (emphasis supplied)

As to claim 6, the cited prior art does not disclose all of the elements and limitations of claim 1, on which claim 6 depends.

Furthermore, Applicant disagrees that Costa-Requena is analogous art because it specifically focuses on SIP and on the setting up of a conference call, which is not a collaboration session in the meaning of the invention.

Second, the URL in Costa-Requena does not comprise accreditations, i.e., some information or data which allows the client access to the collaboration session. The URL in Costa-Requena comprises the location of a group document and the group document itself does not comprise accreditations.

2. The Office Action has not provided a suggestion or motivation to combine the cited references.

Although evidence of a motivation to combine need not be found in the prior art reference themselves, if it is found in the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved, the Office Action must do more than simply discuss the ways that the multiple prior art references can be combined to read on the claimed invention. Rather, the Office Action must point out "specific information in [the two references] that suggest the combination."⁸ "The Board [must] explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination."⁹

In *KSR Int'l Co. v. Teleflex Inc. et.al.*¹⁰, the Court re-affirmed that:

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.¹¹

⁸ See *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1366, 80 USPQ2d 1641, ___ (Fed. Cir. 2006) (citing *In re Dembiczak*, 175 F.3d 994, 999-1000 (Fed. Cir. 1999))

⁹ *Id.* at 1367 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998))

¹⁰ *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727. 82 USPQ2d 1385 (2007)

¹¹ *Id.*

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.¹²

- C. The Examiner has not applied the test of *Graham v. John Deere Co.*¹³ The MPEP requires the Examiner to do so.¹⁴ However, the Examiner has made no finding of the level of ordinary skill in the art.¹⁵

The Federal Circuit routinely vacates conclusions of obviousness when the fact finder failed to make *Graham* factor findings.¹⁶ This is especially so when the fact finder makes conclusory statements that “‘do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”¹⁷

The Supreme Court has re-affirmed this need:

Often, it will be necessary for a court to look to ... the background knowledge possessed by a person of ordinary skill in the art...in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.¹⁸

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

¹² *Id.*

¹³ 383 U.S. 1 (1966)

¹⁴ MPEP § 2141

¹⁵ MPEP § 2141.03

¹⁶ *Dystar*, 464 F.3d 1366 and cases cited therein.

¹⁷ *Id.*

¹⁸ KSR, 550 U.S. ____ (2007)

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

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